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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,830	04/16/2004	Edmond Heng Lim	LIM3	1722
45498	7590	11/03/2005	EXAMINER	
RISTO A. RINNE, JR. COMPLETE PATENTING SERVICES 2173 EAST FRANCISCO BOULEVARD, SUITE E SAN RAFAEL, CA 94901			WUJCIAK, ALFRED J	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/826,830

Applicant(s)

LIM, EDMOND HENG

Examiner

Alfred Joseph Wujciak III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 14, 19-21 is/are rejected.
- 7) ☒ Claim(s) 6-8, 12, 13 and 15-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is the final Office Action for the serial number 10/826,830, PAPER PLATE BEVERAGE HOLDER, filed on 4/16/04.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-8 and 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, line 10 and claim 21, line 14, "portion that extends beyond a rim of said paper" is indefinite because it need have some measurement or dimension to define the distance between the portion and the rim of paper plate.

Claim 4, line 3 and claim 10, lines 3-4, "said paper plate" cites combination/subcombination problem because "paper plate" is not positively cited in claim 1.

Claims 2-4, 6-8 and 11-20 are rejected as depending on rejected claim 1.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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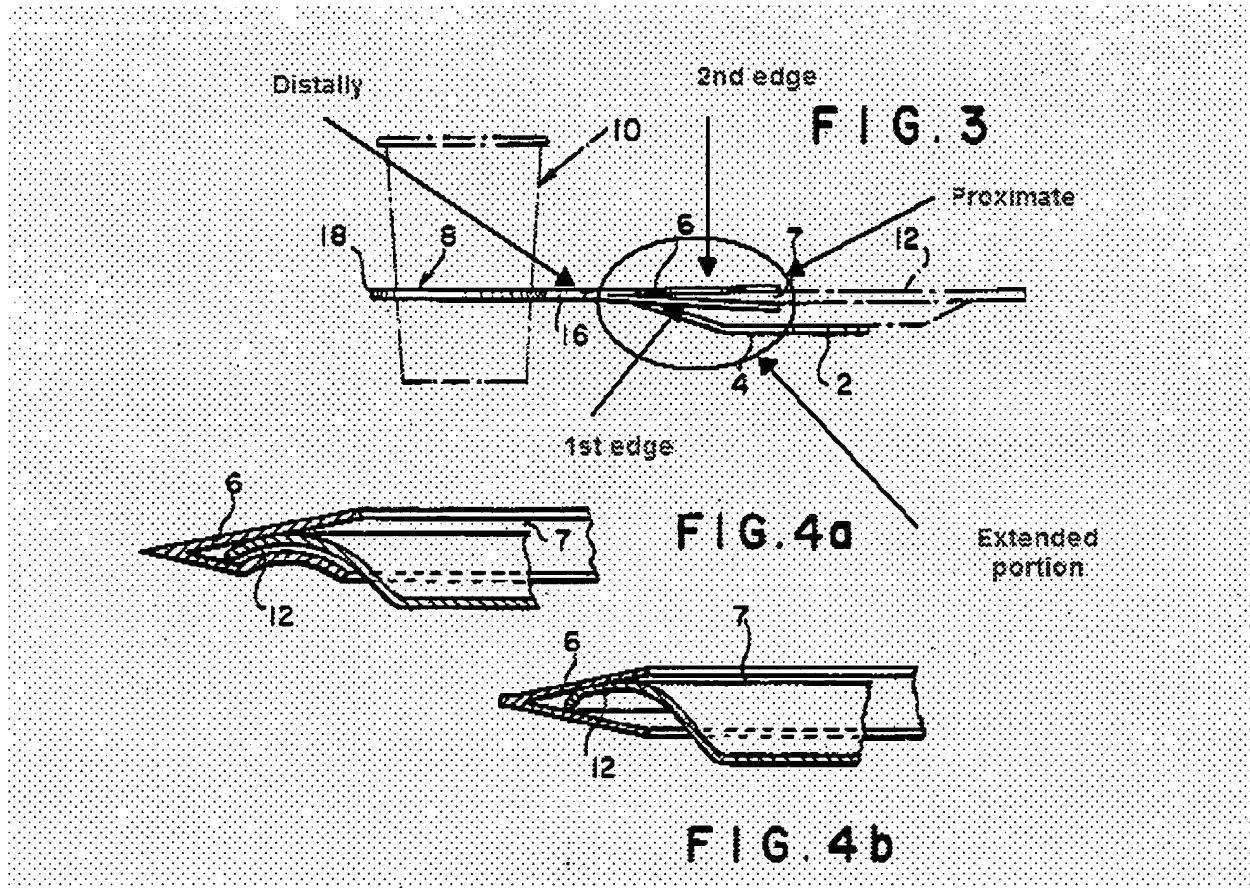
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by

US Patent # 5,110,170 to Boatwright.

Boatwright teaches a holder comprising means for holding (16) a beverage container and means for attaching (4) the means for holding a beverage to the paper plate. The means for holding comprising a substantially planar member (16) including a portion and an opening in the planar member (hole inside of element 18). The planar member includes an extended portion that extends beyond the rim of the paper plate (figure 3). The extended portion includes a first edge that begins proximate the paper plate and extends therefrom (bottom part of element 6 in figure 4b) and an opposite second edge that begins proximate the paper plate and extends therefrom (top part of element 6 in figure 4b). The first and second edges include an opposite end that is disposed distally from the paper plate. The extended portion includes an outer periphery (7). The beverage holder is formed of a material other than paper (plastic, col. 2, lines 28-29).

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### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boatwright in view of US Patent # 6,609,625 to Gibbar.

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Boatwright teaches the means for attaching but fails to teach the means for attaching includes an adhesive. Gibbar teaches the means for attaching (34) includes adhesive. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added adhesive to Boatwright's means for attaching to provide permanent connection between a plate and the means for attaching.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boatwright in view of Gibbar and in further view of US Patent # 6,807,761 to Rappaport et al.

Boatwright in view of Gibbar teaches the means for attaching includes an adhesive but fails to teach the adhesive includes a peel-off strip. Rappaport et al. teaches adhesive (24) with a peel off strip (26). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added the peel off strip to Boatwright in view of Gibbar's adhesive as taught by Rappaport et al. to provide protection for the adhesive from external object when not being used.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boatwright in view of US Patent # 2,916,180 to Alger.

Boatwright teaches means for attaching includes forming the paper plate beverage holder as an integral part of the plate (12) but fails to teach the plate is paper. Alger teaches the paper plate (col. 1, line 23). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Boatwright's plate with paper plate as taught by Alger to provide convenience for disposing paper in the garbage.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boatwright in view of US Patent # 4,961,555 to Egan, Jr.

Boatwright teaches the opening for beverage container but fails to teach the opening contains means for providing a support under the opening. Egan, Jr. teaches the opening (figure 1) with means for providing a support (12) under the opening. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have added the means for providing a support to Boatwright's opening as taught by Egan, Jr. to provide support for retaining the beverage container in the opening.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boatwright in view of US Patent # 4,033,489 to Fowler.

Boatwright teaches the beverage holder but fails to teach the beverage holder is made of paper. Fowler teaches the beverage holder (10) is made of paper (col. 2, line 47). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Boatwright's beverage holder to paper as taught by Fowler to provide convenience for disposing paper in the garbage.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boatwright.

Boatwright teaches a holder comprising means for holding (16) a beverage container and means for attaching (4) the means for holding a beverage to the paper plate. The means for holding comprising a substantially planar member (16) including a portion (6) and an opening in

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the planar member (hole inside of element 18). The planar member includes an extended portion that extends beyond the rim of the paper plate (figure 3). The extended portion includes a first edge that begins proximate the paper plate and extends therefrom (bottom part of element 6 in figure 4b) and an opposite second edge that begins proximate the paper plate and extends therefrom (top part of element 6 in figure 4b). The first and second edges include an opposite end that is disposed distally from the paper plate. The extended portion includes an outer periphery (7). The beverage holder is formed of a material other than paper (plastic, col. 2, lines 28-29).

Boatwright teaches all elements above but fails to teach the use of elements in method. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have specified steps for elements to provide convenience for attaching the holder to the beverage container and paper plate without dropping one of them during attachment process.

#### *Allowable Subject Matter*

Claims 6-8, 12-13 and 15-18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

In regard to claims 6-8, the prior art fails to teach wherein the portion that is adapted to be attached to the paper plate includes a section of overlap that is adapted to be attached to at least a portion of a rim of the paper plate. In regard to claims 12-13, the prior art fails to teach wherein the opening is disposed in the extended portion intermediate the rim of the paper plate and the outer periphery. In regard to claims 15-18, the prior art fails to teach wherein means for



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providing a support includes a first beverage support member disposed on a first side of the extended portion.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-4, 6-8 and 11-21 have been considered but are moot in view of the new ground(s) of rejection.

In the amended claims 1 and 21, they did not include all of features of claims that were objected in the previous office action. The applicant made the independent claims 1 and 21 broader and the examiner is able continue with same reference to reject the claims.

With respect to applicant's argument on page 11, stating that "paper plate" is being positively cited in preamble of claim 1. The examiner disagrees because claim 1, line 2 cited "adapted for use with a paper plate" and that the paper plate is not being positively cited. The holder is adapted to use or mount on the paper plate. In claim 4, lines 3-4, "paper plate" is now positive which cause combination/subcombination problem since "paper plate" is not being positively cited in the preamble of claim 1. If the applicant amended the claim language in claim 4, to ---wherein said means for attaching includes forming said paper plate beverage holder that is adapted to integral with part said paper plate.---, it will overcome the 112 rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Joseph Wujciak III whose telephone number is (571) 272-6827. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6815. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alfred Joseph Wujciak III

Examiner

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10/31/05

